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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,646	08/07/2001	Craig M. Janik	5532.P006X	7462

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09/20/2004

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EXAMINER

NGUYEN, JOSEPH D

ART UNIT PAPER NUMBER

2683

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,646

Applicant(s)

JANIK, CRAIG M.

Examiner

Joseph D Nguyen

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 16-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-14, 16 and 19, 32-33, 35-36, and 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Schultheiss (6,208,384).

Regarding claim 10, Schultheiss discloses a method comprising:

- a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network (internet or cable or satellite) to a computer (abstract, fig. 1, col. 1 line 63 thru col. 2 line 15); and
- b) automatically sending the digital data from the computer to a television using a wireless data transceiver (col. 8 lines 3-10); and
- c) manipulating the digital data on the television from a portable electronic device (remote control) (#50 fig. 1, col. 5 lines 54-63).

Regarding claim 11, Schultheiss further discloses the method of claim 10 further comprising converting the digital data to a format capable of being displayed on the television (col. 8 lines 29-39).

Regarding claim 12, Schultheiss further discloses the method of claim 10 further comprising manipulating the digital data on the client device from the computer (fig. 1, col. 7 lines 36-50).

Regarding claim 13, Schultheiss further discloses the method of claim 12 wherein manipulating the digital data on the client device from the computer includes sending signals to the computer via a remote controller (fig. 1, col. 5 lines 44-65).

Regarding claim 14, Schultheiss further discloses the method of claim 10 further comprising manipulating the digital data on the client device from a website (online or internet) (col. 7 line 34 thru col. 8 line 2).

Regarding claim 16, Schultheiss further discloses the method of claim 10 further comprising retaining user specified preferences in a database on the computer (col. 1 line 63 thru col. 2 line 15, and col. 8 lines 48-67).

Regarding claim 19, Schultheiss discloses a machine-readable storage medium (server with memory) tangibly embodying a sequence of instructions executable by the machine to perform a method (abstract, col. 6 lines 5-16), the method comprising:

- a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 1 line 63 thru col. 2 line 15); and
- b) automatically sending the digital data from the computer to a television using a wireless data transceiver (col. 8 lines 3-15); and
- c) manipulating the digital data on the television from a portable electronic device (col. 5 lines 54-63).

Regarding claim 32, Schultheiss discloses a method comprising:

- a) determining a plurality of preferences based on primary digital data sent to a television (abstract, fig. 1-3, col. 7 line 36 thru col. 8 line 67);
- b) automatically searching for related ancillary digital data on a wide area network based on the preferences (when the computer receives the external information from such cable television or satellite television or the internet based on the user interest which means the cable television or satellite television or the internet automatically searching for related ancillary digital data on a wide area network based on the preferences of the user) (abstract, fig. 1-3, col. 1 line 11 thru col. 2 line 15);
- c) receiving the related ancillary digital data to a computer (abstract, fig. 1-3, col. 1 line 63 thru col. 2 line 15); and
- d) automatically sending the related ancillary digital data to a client device using a wireless data transceiver (abstract, fig. 1-3, col. 8 lines 3-15).

Regarding claim 33, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 35, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 36, Schultheiss further discloses the method of claim 32 further comprising obtaining new ancillary digital content in response to changing the primary content on the television (when the channel is changed on TV, which means the system has to obtain the new ancillary digital content in response to changing the primary content on the television) (col. 7 lines 36-67).

Regarding claim 38, Schultheiss further discloses the method of claim 32, wherein the primary digital content inherently includes audio and video digital content playable on the television (col. 8 lines 3-47).

Regarding claim 39, Schultheiss further discloses the method of claim 32, wherein the ancillary digital content inherently includes audio and video digital content related to the primary digital content playable on the client device (col. 8 lines 3-47).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultheiss (6,208,384) in view of Evans et al. (6,650,889).

Regarding claim 7, Schultheiss further discloses the method of claim 10 of web access (internet). However, Schultheiss does not specifically disclose tagging digital content to aggregate a record of that content on a tag aggregation webpage.

Evan et al. teaches tagging digital content to aggregate a record of that content on a tag aggregation webpage (abstract, col. 5 lines 1-30). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Schultheiss system with the teaching of Evan et al. of tagging digital content to

aggregate a record on webpage in order to transmit the webpage back in HTML format to the client device when client device interacts with webpage.

Regarding claim 34, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 37, this claim is rejected for the same reason as set forth in claim 17.

5. Claims 18, 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultheiss (6,208,384) in view of Macrae et al. (6,052,145).

Regarding claim 18, Schultheiss further discloses the method of claim 10 further comprising the client device (television). However, Schultheiss does not specifically disclose identifying the client device by a specified serial number.

Macrae et al. teaches identifying the client device by a specified serial number (col. 5 lines 35-61, and col. 19 lines 9-34). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Schultheiss system with the teaching of Macrae et al. of identifying the client device by a specified serial number in order to transfer the data to the correct subscriber and to bill the customer for the service.

Regarding claim 20, Schultheiss discloses a method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 1 line 63 thru col. 2 line 15); and

b) automatically sending the digital data to the television using a wireless data transceiver (col. 8 lines 3-10).

However, Schultheiss does not specifically disclose turning on a television at a specified time based on the preferences.

Macrae et al. teaches turning on a television at a specified time based on the preferences (fig. 1, col. 5 lines 2-34). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Schultheiss system with the teaching of Macrae et al. of turning on a television at a specified time based on the preferences in order to watch the program of interest at a specified time.

Regarding claim 21, Schultheiss further discloses the method of claim 20 further comprising using the remote control to send the signal to command the television to change channel (col. 5 line 10 thru col. 6 line 54). However, Schultheiss does not specifically disclose shutting the television off for a predetermined period of time in response to a remote controller sending a signal to the computer.

Macrae et al. teaches shutting the television off for a predetermined period of time (switch itself off at certain time selected by user) (fig. 24-25, col. 5 lines 2-34). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Schultheiss system with the teaching of Macrae et al. shutting the television off for a predetermined period of time in order to switch itself off when the program is ending to avoid the charge.

Regarding claim 22, Macrae et al. further discloses the method of claim 21 wherein shutting the television off includes stopping the sending of digital data to the television (col. 4 line 66 thru col. 5 line 34).

Regarding claim 23, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 25, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 26, Schultheiss discloses a method comprising:

a) automatically obtaining and transferring digital data based on user specified preferences from a wide area network to a computer (abstract, fig. 1, col. 1 line 63 thru col. 2 line 15); and

b) automatically sending the digital data to the audio playback device (the television) using a wireless data transceiver (col. 8 lines 3-10).

However, Schultheiss does not specifically disclose turning on an audio playback device at a specified time based on the preferences.

Macrae et al. teaches turning on an audio playback device (a television) at a specified time based on the preferences (fig. 1, col. 5 lines 2-34). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Schultheiss system with the teaching of Macrae et al. of turning on an

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audio playback device at a specified time based on the preferences in order to watch the program of interest by the user at the time of specified.

Regarding claim 27, this claim is rejected for the same reason as set forth in claim 21.

Regarding claim 28, this claim is rejected for the same reason as set forth in claim 22.

Regarding claim 29, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 30, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 31, this claim is rejected for the same reason as set forth in claim 16.

Response to Arguments

6. Applicant's arguments with respect to claims 10-14, and 16-39 have been considered but are moot in view of the new ground(s) of rejection.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label
"PROPOSED" OR "DRAFT")

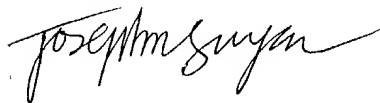
Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington. VA. Sixth floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Joseph D Nguyen whose telephone number is (703)
605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers
for the organization where this application or proceeding is assigned are (703) 872-9314
for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 306-
0377.

Joseph Nguyen



Sept. 16, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600